

In re: Seveso et al.
Application No.: 09/743,173
Filed: January 14, 2002
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REMARKS

Applicants request that the Examiner enter the foregoing amendments. Applicants submit that the amendments place the case in condition for allowance, or, alternatively, in better form for appeal.

Upon entry of the foregoing amendment, claims 1, 44-52, and 55-65 are pending in the application, with 1, 57-59, 61, and 63-65 being the independent claims. Claim 43 has been canceled without prejudice or disclaimer. Claims 1 and 44 have been amended. Claim 1 has been amended to claim the invention with more particularity. Support for the amendment to claim 1 is found in the specification at page 12, lines 29-31 and at page 13, line 31 to page 14, line 3. Claim 44 has been amended to change the dependency due to the cancelation of claim 43. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Applicants appreciate the indication in the Office Action mailed April 9, 2009 that claims 57-65 are allowed.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Rejections Under 35 U.S.C. § 112

(A) Claims 1, 43-52, 55, and 56 have been rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. (Office Action, page 2). Applicants respectfully traverse this rejection.

The Examiner alleges that the cited dose range of 0.013 mM to 13 mM when the enhancer has a carbon chain length of from 9 to 14 carbon atoms is new matter as the specification only discloses an enhancer having 10 carbon atoms in the dose range. (Office Action, page 3).

Applicants respectfully disagree. Claim 43 has been canceled, rendering that portion of the rejection moot. While Applicants disagree with the Examiner's reasoning, to expedite

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prosecution claim 1 has been amended to recite “wherein the amount of enhancer effective to enhance the intracellular delivery is about 0.013 mM to 13 mM when said enhancer has a carbon chain length of 10 carbon atoms and 0.12 mM to 120 mM when said enhancer has a carbon chain length of 8 carbon atoms.” The Examiner acknowledged that the recited ranges and carbon chain lengths are explicitly disclosed in the present specification at page 12, lines 29-31 and at page 13, line 31 to page 14, line 3. Thus, the present claims do not contain new matter.

It is respectfully requested that the rejection of claims 1, 43–52, 55, and 56 under 35 U.S.C. § 112 be withdrawn.

(B) Claims 1, 43–52, 55, and 56 have been rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to meet the enablement requirement. (Office Action, page 4). Applicants respectfully traverse this rejection.

The Examiner alleges that, to the extent that the claimed compositions and/or methods are not described in the instant disclosure, the claims are not enabled as a disclosure cannot teach one to make or use something that has not been described. (Office Action, page 4).

Applicants respectfully disagree. As discussed above, the claims as amended do not contain new matter and are adequately described. Thus, the claims are fully enabled by the specification.

It is respectfully requested that the rejection of claims 1, 43–52, 55, and 56 under 35 U.S.C. § 112 be withdrawn.

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CONCLUSION

Applicants believe that the points and concerns raised by the Examiner in the Action have been addressed in full. It is respectfully submitted that this application is in condition for allowance, which action is earnestly solicited. Should the Examiner have any remaining concerns, it is respectfully requested that the Examiner contact the undersigned Attorney at (919) 854-1400 to expedite the prosecution of this application to allowance.

No fee is believed to be due with this response. However, the Commissioner is hereby authorized to charge any deficiency or credit any overpayment to Deposit Account No. 50-0220.

Respectfully submitted,



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CERTIFICATION OF TRANSMISSION

I hereby certify that this correspondence is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4) to the U.S. Patent and Trademark Office on September 8, 2009.

Signature: 
Marthenn Salazar